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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,423	09/22/2003	Yoshihiro Funamizu	03500.017592	6510
5514	7590	11/10/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			BRASE, SANDRA L	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/665,423

Applicant(s)

FUNAMIZU ET AL.

Examiner

Sandra L. Brase

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/16/04 &amp; 11/17/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 11/17/03 cited application 10/594862; however, this application is not considered because Examiner could find no information on 10/594862, and it appears not to exist since the Examiner could find no record of its existence in the USPTO system.

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities.  
  
On line 6 of page 17, "8" should be changed to "80".  
  
On line 11 of page 29, "shit" should be changed to "shift".  
  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bisaiji (US 6,091,922).

5. Bisaiji (...922) discloses an image forming apparatus comprising: a movable image bearing member (9); image forming means for forming a developer image on the image bearing member (col. 2, line 44 – col. 3, line 17); an intermediate transfer member (19) on which the developer image on the image bearing member is transferred while the intermediate transfer member is moving at a predetermined surficial moving speed different from a surficial moving speed of the image bearing member (col. 6, lines 5-39); and control means for controlling the image forming means to form a predetermined image prior to formation of a normal image (col. 9, lines 3-31). The control means controls the image forming means to form the predetermined image in such a way that the predetermined image is adjacent to the normal image (col. 10, lines 5-7). The control means controls the image forming means to form the predetermined image in an area, which is outside a normal image formation area, and which is other than an area downstream of the normal image formation area with respect to an image moving direction (col. 10, lines 5-13). The predetermined image can be formed within a normal image formation area, where the control means controls the image forming means to form a composite image of the normal image and the predetermined image (col. 10, lines 5-7). Transferring means (23) transfers the developer image on the intermediate transfer member onto a transferring material, wherein the control means controls the image forming means to form the predetermined image in an area on the intermediate transfer member to which the transferring material is opposed at the time of transferring by the transferring means (col. 10, lines 5-13). The control means controls

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the image forming means to form the predetermined image as an image in which dot developer images each having a unit area formed by a dot or a plurality of dots are uniformly dispersed (col. 10, lines 5-7). A plurality of image forming means (14, 15, 16 and 17), wherein developer images formed by the plurality of image forming means are sequentially transferred onto the intermediate transfer member (col. 6, lines 23-47 and col. 9, lines 17-21), wherein the control means controls only one image forming means out of the plurality of image forming means, to form the predetermined image (col. 9, lines 24-31), where the one image forming means forms a developer image to be transferred first onto the intermediate transfer member, where the one image forming means that forms the predetermined image forms yellow developer image (col. 9, line 65 – col. 10, line 4). In the case that image formation is performed by only one image forming means out of the plurality of image forming means, the control means controls only the one image forming means to form the predetermined image (col. 9, lines 3-31 and 63-65).

***Allowable Subject Matter***

6. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Matsuduki (US 6,694,114) and Matsuduki (US 6,718,150) disclose adding dots to printed data of an image.

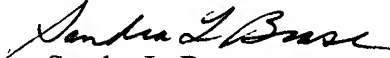
Hwang (US 5,160,946) and Shimada et al. (US 6,285,849) disclose plural image forming units and an intermediate transfer member, where patterns are formed on the intermediate transfer member.

### ***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra L. Brase whose telephone number is 571-272-2131. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur T. Grimley, can be reached on 571-272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sandra L. Brase  
Primary Examiner  
Art Unit 2852

November 8, 2004